

rejection of claims 32-34 and 36 should be withdrawn

In another example, claim 33 recites that the upper and lower middle sides of the cells of the claimed cellular shade are substantially in parallel arrangement. As previously discussed, Applicants submit that the rosette forms a four-sided polygon and therefore does not have upper and lower middle sides. Moreover, assuming *arguendo* that the rosette does have upper and lower middle sides, they would not be parallel because the intended and publicly-used configuration of the rosette is fanned-out and semi-circular. Any "sides" of the rosette cells therefore converge to a central point and are clearly not parallel. For this reason alone, the rejection of claim 33 should be withdrawn.

In another example, all pending claims recite "a cellular shade." To the extent that the rosette is not a cellular shade, Applicants submit that the rejection of claims 1-5, 7-9, 22-26, 29-36 and 44-48, as being unpatentable over the rosette alone, is improper and should be withdrawn.

d. The Rosette Constitutes Non-analogous Art

The rosette applied by the Examiner against the present application is a small, semi-circular decorative facade used in conjunction with semi-circular window shades and other window treatments such as draperies. The rosette is clearly not a window shade, and no one skilled in the art of window treatments would consider the rosette to be a window shade or analogous to a window shade. See Presdorf Decl. ¶ 5, Ford Decl. ¶ 8; Collins Decl. ¶ 5. The intended use of the rosette is a fixed, fanned-out array, it is not retractable like a window shade, nor is it used in any configuration other than a circular, fanned-out configuration. Applicants submit that the rosette constitutes non-analogous art to the presently claimed invention, and therefore, that the Examiner's rejection of the presently claimed invention based on the rosette

is improper and should be withdrawn

All of the evidence submitted in this case, including Comfortex's arguments in the Kirsch Inc. v. Comfortex Corp. litigation, confirms the proposition that rosettes are non-analogous art to the field of window shades. There is simply no evidence to support the Examiner's implicit position to the contrary. According to the Federal Circuit, the test for analogous art is two-prong: it is first determined whether the proposed reference is within the field of the inventor's endeavor, and if not, it must be determined whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. In re Deminski, 796 F.2d 436, 230 U.S.P.Q. 313 (Fed. Cir. 1986). The rosette art does not meet either of these criteria. See Presdorf Decl. ¶ 5. As can be gleaned from Federal Circuit precedent, the standard for determining analogous art is precise. In In re Clay, 966 F.2d 656, 23 U.S.P.Q.2d 1058 (Fed. Cir. 1992), the court held that the prior art process references in that case were non-analogous to the claimed invention, even though both were used in the petroleum industry and both involved handling petroleum products in volumetric enclosures. Whereas the claimed invention recited a method for storing refined petroleum products in a man-made storage tank, the references disclosed a method for extracting crude oil from porous hydrocarbon-bearing materials. Although the claimed invention and the references both related to the petroleum industry, the court held that the differences between them illustrated a different field of endeavor and different purpose, such that one of ordinary skill in the art would not look to the references to solve the problem addressed by the claimed invention.

Under Federal Circuit precedent, Applicants submit that the rosette is non-analogous art from the field of cellular window shades, as described and claimed in the present

application. The rosette is a semi-circular "decorative facade"¹ used in conjunction with various window treatments. It is not within the field of cellular window shades, and it is not pertinent to the problems related to the design and manufacture of cellular window shades. The fact that the rosette represents non-analogous art to the field of window shades is clearly supported by the record. For example, Dorothy L. Collins, a designer and consultant with a speciality in windows and window treatments, states in her declaration that:

"A rosette, however, is not a window shade. It is ludicrous to suggest that a rosette is in any way analogous to a window shade, or that a window shade designer looks to rosettes as the inspiration for a new window shade design." (§ 5)

"No one in the industry, and no consumer, would ever use a rosette as a window shade because a rosette does not perform the function of a window shade. Indeed, rosettes are designed merely to provide a decorative flair to a window shade or to any other window treatment product with which the rosette is used." (§ 6)

"When a window shade is fully extended, it blocks the light entering a home through that window and provides privacy for the home's occupants. A rosette, however, can only cover a fraction of a window's surface area and thereby does not block the light entering the home and does not provide any privacy for the home's occupants." (§ 7)

"When a window shade is fully retracted, it allows light to enter the home unimpeded and lets the home's occupants have a clear view through the window. A rosette, however, cannot be retracted; it is a fixed decorative piece and is not designed to be adjusted." (§ 8)

"A window shade also has some sort of pull mechanism (typically a pull cord) to allow the owner of the home to adjust the position

¹ Comfortex, the manufacturer of the rosette, itself refers to the rosette, or more specifically a double-celled rosette, as a "decorative facade." This can be seen, for example, in U.S. Patent No. 4,934,436, which is assigned to Comfortex: "[r]eference being had to Fig. 3C, the invention is therein exhibited in the fully deployed fan mode and lacks only the finishing touch of a decorative facade to cover the space A that exists at the radial center of the shade because of the absence of shade material directly above the joint network." Col. 8, lines 44-49 (emphasis added).

of the shade from a fully retracted position to a fully extended position. In this manner, the owner can leave the shade in any number of partially-opened positions and thereby regulate the amount of light entering the home. A rosette, however, lacks any means by which the owner can adjust its position. Instead, it is a fixed decoration, much like the valence one might hang above their drapes." (§ 9)

"No one in the window treatment industry would call a rosette a window shade, and no one would ever suggest to a customer that a rosette was anything other than an accessory to be used with a window shade." (§ 10)

"As a designer, I would not look to rosettes for ideas about how to make a new window shade design. It is also my professional opinion that no designer would study a rosette for ideas as to a new window shade design." (§ 11)

Similarly, James A. Ford, having more than 35 years experience in the design and manufacture of window treatments and window coverings hardware, states the following in his declaration

"Based on my 35 years experience in the design and manufacture of window treatments, including window shades, and as an active member in the window dressings trade during this time, it is my opinion that 'rosette' window accessories are not even remotely considered to be 'window shades' within the window treatment community. As such, as a designer of window shades, I would not look to 'rosettes' as an inspiration for new window shade designs. Furthermore, in my opinion, no one in the trade of designing window shades would look to rosettes for such inspiration." (§ 8)

Ronald L. Prestorff, having 20 years experience in the design and manufacture of window shades, states the following in his declaration (attached hereto as Ex. B)

"The rosette is not a window shade and cannot function as a window shade. Rather, the rosette is a four-sided cellular structure that function as a decorative element to be used in conjunction with various window treatments." (§ 4)

"I would not consider a rosette as the basis for arriving at a new window shade design because the rosette is separate and distinct from the field of window shade design and manufacture. Moreover, the rosette does not address the problems sought to be overcome in the design of window shades. Consequently, no one

in the field of shade design and manufacture would look to rosettes for inspiration in developing new window shades " (r. 5)

Applicants submit, particularly in view of statements of record from experts in the field of window shades,² that rosettes are not window shades, are not within the field of window shades, and are not reasonably pertinent to the particular problem of designing and manufacturing window shades. Accordingly, based on the evidence submitted in this case, rosettes are non-analogous to the presently claimed invention, and Applicants are not aware of any evidence to the contrary. Consequently, the use of the rosette as a reference, alone or in combination, against the claimed invention is improper.

c. The Proposed Combination of References Would Destroy the Intended Function of the Rosette

Under Federal Circuit precedent, a rejection under 35 U.S.C. § 103 is improper where the suggested modification of a reference destroys the intent, purpose, or function of the reference. See In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). Applicants submit that the modification of the rosette by Suominen, as suggested by the Examiner, would destroy the intent, purpose, and function of the rosette. The proposed combination of references is therefore improper as a matter of law.

As previously discussed, the rosette is nothing more than a fanned-out "decorative facade" that does not function as a window shade. Its purpose is to serve as a decoration to be used in conjunction with semi-circular window shades and other items such as curtain rods.

² The statements of Ms. Collins, Mr. Ford, and Mr. Presdorf, as experts in the field of the claimed invention, are entitled to fair evidentiary weight. See In re Dow Chem. Co., 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988), accord Ex parte Dussaud, 7 U.S.P.Q.2d 1815 (Bd. Pat. App. Int. 1988).

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